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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,132	02/15/2001	N. Leigh Anderson	41343	1482
7590	12/01/2004			
Large Scale Proteomics Corporation John C. Robbins 3333 Vaca Valley Parkway Suite 1000 Vacaville, CA 95688			EXAMINER CHIN, PAUL T	
			ART UNIT 3652	PAPER NUMBER

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,132

Applicant(s)

ANDERSON ET AL. *ST*

Examiner

PAUL T. CHIN

Art Unit

3652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,22-24,49-51,77-86 and 88-92 is/are pending in the application.
- 4a) Of the above claim(s) 49-51 and 91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,22-24,77-86,88-90 and 92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed August 8, 2004, and the argument presented therewith have been carefully considered. Regarding Danziger (5,344,534), the argument is persuasive in light of amended claims, and the claim rejection has been withdrawn. The claims rejections of Penberthy (4,195,981) or Lyle (2,533,826) have been withdrawn because claims 49-51 have been withdrawn as non-elected invention. However, the arguments on Anderson et al. (5,993,627) are not persuasive. Therefore, applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL.

Election/Restrictions

2. Applicant's election without traverse of Group I, readable on claims 20,22-24,77-86,88-90, and 92, filed on August 6, 2004, is acknowledged.

3. This application contains claims 49-51 and 91, drawn to an invention nonelected with traverse on August 6, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Note that claims 1-19, 21, 25-48,52-76, and 87 have been canceled by applicant.

Claim Objections

4. Claims 23 and 88 are objected to because of the following informalities: it appears that the depending claim "20" (of claim 23) should be changed to -- 22 -- because the structural limitation "magnet" is recited only in claim 22, and also the depending claim "87" (of claim 88) should be changed to -- 86 -- because claim 87 has been canceled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20,22-24,77-86,88-90, and 92, are rejected under 35 U.S.C. 102(e) as anticipated by **Anderson et al. (5,993,627)** or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Anderson et al. (5,993,627)** in view of **Anderson (4,088,561)**.

Anderson et al. (5,993,627) discloses a method for manipulating an electrophoresis gel slab, comprising a first clamp (104, (see Figs. 9H-9K), (138) (Fig. 11B), 66,66 (Fig. 7)) and a second clamp (105) (137) (Fig. 11B) (66) (Fig. 7) having an operating end and a gripping end being biased towards each other; a gel slab (89,97); gripping a side edge of the gel; moving an arm to above a gel tank (see Figs. 7,11A, and 12) containing a staining liquid (132) contained in a tank (130) or vessel and supporting the clamp (Fig. 12)

Re claims 22,23,80, and 81, the first and second jaws have magnets (140) (Fig. 11B) for biasing the gripping ends, each magnet is contained on each clamp.

Re claim 78, figure 11B shows a hinge (139) between a first clamp (138) and a second clamp (139).

Re claim 82, the "solution in the tank can be agitated when required by a variety of means well known in the photographic processing industry" (Col 24, lines 24-34).

Re claims 83,84, and 88, Figure 7 shows a belt motor (75), gripper (66,66), arm (70), and pneumatic cylinder (67) causes the vertical motion (Col 18, lines 16-33) and also linear motion means (100,101) (see Figs. 8A-E) to hold and grip gel wherein the belt motor (75) and linear motion means (100,101), which can be considered as an agitating motor, operatively connected to the reciprocating member (Fig. 7), to move in a vertical direction.

Re claim 85, a plurality of gel slabs in a parallel spaced apart relationship in figures 10 and 11A.

Re claims 84 and 88, Anderson (4,088,561) discloses an apparatus for electrophoresis having an agitating motor (43) disposed within a solution. Accordingly, it would have been obvious design choice to provide an agitating motor on the system of Anderson et al. (5,993,627), as an alternative embodiment, as taught by Anderson's apparatus for electrophoresis separation to agitate the retaining solution.

Response to Arguments

8. Applicant's amendment filed August 8, 2004, and the argument presented therewith have been carefully considered. Regarding Danziger (5,344,534), the argument is persuasive in light of amended claims, and the claim rejection has been withdrawn. The claims rejections
-

of Penberthy (4,195,981) or Lyle (2,533,826) have been withdrawn because claims 49-51 have been withdrawn as non-elected invention.

Applicant argues that "Anderson et al. (5,993,627) does not teach a clamp" (pages 9 and 10). The arguments are not persuasive because the prior art discloses a method for manipulating an electrophoresis gel slab, comprising a first clamp (104, (see Figs. 9H-9K), (138) (Fig. 11B), 66,66 (Fig. 7)) and a second clamp (105) (137) (Fig. 11B) (66) (Fig. 7) having an operating end and a gripping end being biased towards each other. The first clamp and the second clamp are movable jaws biasing toward each other as applicant recited. Figs. 9H-K discloses clamps (105,106) pivotally clamping a gel (89), and figure 11B shows a half clamp (138) and another half clamp (139) which are pivoted at a pivot (142) clamping a gel. Therefore, the prior, as broadly recited in the claims, discloses the structural limitations and capable of performing the functional limitations. The argument on the "agitating motor (29) of Fig. 3" (page 10) is persuasive. However, figure 7 shows a belt motor (75), gripper (66,66), arm (70), and pneumatic cylinder (67) causes the vertical motion (Col 18, lines 16-33) and also linear motion means (100,101) (see Figs. 8A-E) to hold and grip gel wherein the belt motor (75) and linear motion means (100,101), which can be considered as an agitating motor, operatively connected to the reciprocating member (Fig. 7), to move in a vertical direction. In the alternative, claims 84 and 88 are rejected under 35 U.S.C. 102(e) as anticipated by Anderson et al. (5,993,627) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson (4,088,561). Anderson (4,088,561) discloses an apparatus for electrophoresis having an agitating motor (43) disposed within a solution. Accordingly, it would have been obvious design choice to provide an agitating motor on the system of Anderson et al.

(5,993,627), as an alternative embodiment, as taught by Anderson's apparatus for

electrophoresis separation to agitate the retaining solution. Therefore, Anderson et al. (5,993,627) alone or Anderson et al. (5,993,627) in view of Anderson (4,088,561), as broadly as recited, alone or discloses the structural limitations and capable of performing the functional limitations.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment (the additions of new limitations on claims 20, 86,88, and new claims 89-92, in combination with other limitations) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (703) 305-1524. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (703) 308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ptc

PTC
November 17, 2004



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